IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.:	09/449,021	Confirmation No.:	5718
Applicant:	Emmelmann	Group Art Unit:	2192
Filing Date:	11/24/1999	Examiner:	C. Kendall
Customer No.:	8685		

For: INTERACTIVE SERVER SIDE COMPONENTS

INTERVIEW SUMMARY

SUBMITTED THROUGH EFS-WEB

INTERVIEW SUMMARY

Dear Commissioner for Patents:

During the period of January through April of 2011, applicant Helmut Emmelmann and his counsel Richard Nebb conducted a number of telephone interviews and exchanged email correspondence (see attached) with PTO personnel in an attempt to resolve various issues involved in the pending appeal of parent application U.S. App. No. 09/449,021, and in the related prosecution of co-pending child application U.S. App. No. 12/966,976. Applicant notes that the child was filed with claims that had been allowed in the original Examiner's Brief in the parent, some of which had been dependent claims in the parent, rewritten into independent form. The PTO personnel involved in some or all the telephone interviews and/or email correspondence were: Chuck Kendall, Primary Examiner, Art Unit 2192; Lewis Bullock, SPE, Art Unit 2193; and Gail Hayes, SPE, Technology Center 2100.

In the first few discussions, the PTO personnel sought an understanding of how the claimed subject matter was described in the specification, and applicant provided

citations and explanations, many of which are reflected in the email correspondence. These discussions also included applicant's arguments as to why the cited art does not show the claimed limitations, and why applicant believes that the Examiner's interpretation of the prior art is overbroad and incorrect, all of which is discussed in applicant's Appeal Brief and Reply Briefs in the parent.

Subsequent discussions focused on the pending claim language, proposed revisions to the claim language, as well as discussions of how to apply the cited prior art, including the Faustini patent, [1] which has now been used by the Examiner to form a new rejection in both the parent and the child.

Applicant also requested that recently cancelled claims in the parent, indicated as allowable in the original Examiner's Answer, then moved to the child and cancelled from the parent, be re-instated into the appeal in the parent, but applicant's request was denied.

While applicant and the PTO personnel were ultimately not able to agree on any resolution of issues affecting the pending appeal in the parent case, the PTO personnel proposed some changes based on which there was agreement that certain revised claim language would be allowable over the cited art. This agreed upon claim language has been incorporated into certain claims of the child, namely, into independent claims 1, 8, 11, 12, 21, 24 and 41, and these claims were recently indicated as allowable in an Office Action in the child dated September 7, 2011.

Respectfully submitted,

Date: _October 11, 2011___   By: _____/Richard A. Nebb/_____
                                              Richard A. Nebb
                                              Reg. No. 33,540

DERGOSITS & NOAH LLP
3 Embarcadero Center, Suite 410

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1. U.S. Patent No. 5,842,020 to Faustini was originally cited by the Examiner in the parent during a telephone conference with Mr. Nebb in January 2008, and was made of record by applicant in the Information Disclosure Statement filed October 17, 2008; thereafter, Faustini was identified as pertinent art by the Examiner in the Office Action dated July 1, 2009 in the parent. Faustini is now cited as a new basis for rejection in the replacement Examiner's Answer dated July 12, 2011 in the parent, as well as in the Office Action dated September 7, 2011 in the child.

U.S. App. No. 09/449,021   2

San Francisco, California 94111
Telephone: (415) 705-6377
Facsimile: (415) 705-6383
rnebb@dergnoah.com

attachment A: Email correspondence in U.S. App. No. 09/449,021

attachment B: Email correspondence in U.S. App. No. 12/966,976

> ⊕ You forwarded this message on 3/16/2011 8:28 AM.
> This message was sent with high importance.

Rich Nebb

From:	Rich Nebb	**Sent:** Wed 3/16/2011 7:45 AM
To:	gail.hayes@uspto.gov	
Cc:		
Subject:	Telecon 3/16 re 09/449021	
Attachments:		

Dear Ms. Hayes,

Please use the following call-in number today at 2 pm EDT:
(712) 432-1630
code 500311#

Also, we prepared the following comments after the last inteview session:

Introduction

In preparation for the upcoming interview, applicant has again reviewed its claims and specification, and believes that distinctive feature 2 (discussed below) is recited in claim 1. It is Applicant's hope that the examiners can tell him: (1) that distinctive feature 2 is novel, and (2) how to correct the language recited in claim 1 to accurately describe this feature.

Distinctive Feature 1: Functional Application During Editing.

This feature has been discussed extensively in the interview it underlies claims 26 ("appears and functions similar") and 59 ("look and function similar"). This feature makes clear the benefit of the invention and has been the focus of our discussions. Applicant's editor beneficially shows the application that is being edited (i.e., at least one template page) in a functional and running way during editing, and in particular, dynamically generated code (e.g., by the components) is displayed. In contrast, the WebWriter articles do not show the application being edited in a functional way inside the editor - placeholders are displayed for the dynamic areas.

Distinctive Feature 2: Integrated Document Generator.

This feature was mentioned briefly at the end of the interview, but applicant notes that Claim 1 (and 22 and partly 59) directly recite this second distinctive feature as well. WebWriter and applicant's system both have a document generator for running an application <u>after</u> it has been created and/or edited and saved with an editor. However, in applicant's system, this same document generator is also used during editing: that is, a single integrated document generator is used for running and for

editing. In contrast, the WebWriter articles both describe separate page generators: one for normal running of the application, and one for displaying the preview frame.

Benefit

Because of the integrated document generator in applicant's system, an application being edited appears running and functional during editing, and browser code generated by components is displayed during editing. WebWriter appears to only show placeholders for dynamic areas during editing.

Terminology

The terms "web application" and "server side internet application" are described in ¶¶ 2-6 -of the published application. ¶73 says "By adding components to a page, the page becomes a dynamic page or server side application." Thus, a single template page having a dynamic component is considered an application. This is also stated in ¶ 22: "It is an object of the invention to provide a tool and a technique to develop server side web applications by composing them out of interactive server side components and placing them on page templates."

WebWriter sees an application as a stack of template pages (WebWriter II @ Sec. 1.1).

How is Distinction 2 reflected in the Prior Art

WebWriter has a page generator called the WebWriter Page Generator for running the edited applications: "*In addition to the Editor the WebWriter system includes the WebWriter Page Generator, a server based CGI service that creates new pages as a WebWriter-built application runs*" (WebWriter II, p. 1507, last line, emphasis added). This program is not described in detail in the WebWriter II article, but the WebWriter I article describes the WebWriter Page generator on p. 9, left column. The currently pending final rejection relies on it.

In addition, the WebWriter II article discloses a second page generator (sec. 4.1.3 on p. 1513) for populating the preview frame. It is implemented in javascript working inside the browser. In applicants reading, section 4.1.3 does not seem to contain any teaching about running the edited application. In addition, running a server side web application using a page generator inside a browser would be hard or even impossible. (note: WebWriter I has a page generator on the server that shows the preview. WebWriter II moved this page generator into the browser).

In addition to the preview frame page generator in section 4.1.3, WebWriter II has other page generators for generating the pages displayed in the other frames, for

example, as discussed in sec. 4.1.4 for the object properties frame (p. 1513). These other frames, however, show parts of the WebWriter II user interface, and **not a preview** or a representation of the page being edited (see Figs. 1 and 2 and sec. 3 on p. 1509).

WebWriter I has a page generator outside the browser that shows the preview. WebWriter II moved this page generator into the browser

How is Distinction 2 reflected in the Specification

Applicant introduces a program called ISSC processor, described in ¶¶ 112-154 of the published application, for running the applications being edited. The integration of the ISSC processor and the edit processor is described in ¶¶ 205-208, and more details on how the ISSC processor is extended are provided in ¶¶ 226-246.

Rationale of Claim 1

Claim 1 implicates the distinctive integrated document generator by requiring that the output of the document generator that runs at least part of the application has editing features. This feature overcomes WebWriter II because WebWriter II has separate page generators for running and for editing and not an integrated page generator for doing both.

Construction of Claim 1

The preamble of claim 1 defines **the applications** as software applications that run on a data network, whereupon request by the browser program, at least one of the applications generates generated documents for display by the browser program and responds to the request with the generated documents. This also defines "**the generated documents**" as the output of at least one of the applications which the application generates as response to a request from the browser.

The preamble also requires "*computer programs having executable instructions for editing software applications*" which indicates that **the applications** are being used for those applications that are subject of being edited in the context of the claim.

Basis for Rejection of Claim 1

Applicant thinks that any rejection should identify which one of the multiple page generators described in the WebWriter system is cited against the claimed document generator. As it stands, the examiners have been vague regarding how the art is applied to the claims, in particular, with regard to the page generators described in

secs. 4.1.3 and 4.1.4 of WebWriter II, discussed below.

Patentability of Claim 1

None of the page generators described in the WebWriter articles fulfills the limitations of claim 1.

Also, Claim 1 requires the document generator to provide the generated documents to the browser in response to a request - the recited document generator is required to generate **the generated documents,** and the preamble requires upon request by the browser program at least one of the applications responds to the request with **the generated documents**. The documents generated by the WebWriter II page generator of sec. 4.1.3 are already present in the browser and there appears to be nothing in WebWriter II that responds to a request with the documents generated by this page generator.

WebWriter II also describes a page generator in sec. 4.1.4, but this page generator generates documents shown in the object properties frame, which shows part of the editor UI but not a representation of documents generated by one of the edited applications.

Long pendency; no real prospect for term extension

Applicant first filed a Notice of Appeal in September 2005, and in applicant's view, the claims have not really changed much in scope during that time.

Further, it seems the positions of the PTO and applicant have not changed much during that time either, although the art relied upon has changed. For example, in the Advisory Action dated November x 2005, the PTO said *"It would however be distinct, if Applicant claimed dynamically editing a web page while the web page is being run on the browser."*

Absent any term extension, the remaining term if a patent issued today on this app is roughly 8 years, 8 months (November 2019), a value that is grossly unjust to applicant in light of the prosecution history.

Applicant and Attorney fear that since this application was filed prior to May 2000, the term extension rules of the former statute 35 USC 154(b) apply, not the current rules, and seek the examiners' confirmation. (See MPEP §2720). Under the former statute, the only applicable provision is "extension for appellate review." However, there must be "a decision in the review reversing an adverse determination of patentability" (and the patent must not be subject to a terminal disclaimer). Under a 2004 rule change,

certain remands by the Board can be considered a "decision" for the purpose of term extension. (37 CFR §1.701).

First and foremost, it is clearly desirable to obtain allowable claims and get patent(s) issued as soon as possible (although this may lead to a terminal disclaimer, which may impact term extension in the appealed app). Thus, it appears that the only potential prospects for term extension lie with pursuing an appeal (which may or may not be successful) or obtaining a remand from the board. The examiners confirmation of these possibilities is sought.

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┌───┐
│ ⊕ You forwarded this message on 3/16/2011 10:47 AM. │
└───┘
Rich Nebb

From:	Hayes, Gail [Gail.Hayes@USPTO.GOV]	**Sent:** Wed 3/16/2011 10:32 AM
To:	Rich Nebb	
Cc:		
Subject:	RE: Telecon 3/16 re 09/449021	
Attachments:		

ok

From: Rich Nebb [mailto:rnebb@dergnoah.com]
Sent: Wednesday, March 16, 2011 10:46 AM
To: Hayes, Gail
Subject: Telecon 3/16 re 09/449021
Importance: High

Dear Ms. Hayes,

Please use the following call-in number today at 2 pm EDT:
(712) 432-1630
code 500311#

Also, we prepared the following comments after the last inteview session:

Introduction

In preparation for the upcoming interview, applicant has again reviewed its claims and specification, and believes that distinctive feature 2 (discussed below) is recited in claim 1. It is Applicant's hope that the examiners can tell him: (1) that distinctive feature 2 is novel, and (2) how to correct the language recited in claim 1 to accurately describe this feature.

Distinctive Feature 1: Functional Application During Editing.

This feature has been discussed extensively in the interview it underlies claims 26 ("appears and functions similar") and 59 ("look and function similar"). This feature makes clear the benefit of the invention and has been the focus of our discussions. Applicant's editor beneficially shows the application that is being edited (i.e., at least one template page) in a functional and running way during editing, and in particular, dynamically generated code (e.g., by the components) is displayed. In contrast, the WebWriter articles do not show the application being edited in a functional way inside the editor - placeholders are displayed for the dynamic areas.

Distinctive Feature 2: Integrated Document Generator.

Rich Nebb

From:	Rich Nebb	**Sent:**	Fri 3/18/2011 5:40 AM
To:	gail.hayes@uspto.gov		
Cc:			
Subject:	follow up re 09/449021		
Attachments:			

Dear Ms. Hayes,

I am a little confused about procedure if the client proceeds with appeal - you have said you would not send the case to the board on the current ground of rejection. Does that mean you will issue a new office action stating the new grounds of rejection? And if so, does that take us out of the appeal queue and start us over again, with a new Notice of Appeal and new briefs? Please clarify.

Thank you!

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Rich Nebb

From:	Hayes, Gail [Gail.Hayes@USPTO.GOV]	**Sent:**	Mon 3/21/2011 12:49 PM
To:	Rich Nebb		
Cc:			
Subject:	RE: follow up re 09/449021		
Attachments:			

Please see MPEP 1207.03 (V). You have the option of maintaining the appeal by and sending in a response to the new grounds or requesting that the prosecution be reopened and responding to the new grounds

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From: Rich Nebb [mailto:rnebb@dergnoah.com]
Sent: Friday, March 18, 2011 8:40 AM
To: Hayes, Gail
Subject: follow up re 09/449021

Dear Ms. Hayes,

I am a little confused about procedure if the client proceeds with appeal - you have said you would not send the case to the board on the current ground of rejection. Does that mean you will issue a new office action stating the new grounds of rejection? And if so, does that take us out of the appeal queue and start us over again, with a new Notice of Appeal and new briefs? Please clarify.

Thank you!

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Rich Nebb

From:	Rich Nebb	**Sent:**	Mon 3/21/2011 9:17 AM
To:	lewis.bullock@uspto.gov		
Cc:			
Subject:	claim 1 re 09/449021		
Attachments:	📄 claim1_proposal.doc(24KB)		

Per our discussion, a proposal for claim 1 is attached.

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1. (previously presented) A computer-readable medium encoded with computer programs having executable instructions for editing software applications that run on a data network which couples a server computer and a client computer, wherein the client computer runs a browser program, and whereupon request by the browser program, at least one of the applications generates generated documents for display by the browser program on a display device and responds to the request with the generated documents, comprising:

a document generator program for running at least part of one of the applications being edited and generating the generated documents, ~~said generated documents including additional editing features for interpretation by the browser program; and~~

instructions for execution during the generating of the generated documents for including editing features for interpretation by the browser program into the generated documents; and

an editor program for dynamically operating on the generated documents displayed by the browser program via the editing features.

Rich Nebb

From:	Rich Nebb	**Sent:**	Wed 3/23/2011 6:47 AM
To:	lewis.bullock@uspto.gov		
Cc:			
Subject:	claims for discussion re 09/449021		
Attachments:			

Dear Mr. Bullock:

We previously sent you a proposed amendment for discussion with regard to claim 1 only. We are now including proposals (see below) for discussion with regard to the other independent claims, and also, with regard to claim 1 of the child case (12/966,976), as well as selected comments.

We are scheduled to talk by telephone on Thursday March 24th at 2 pm EDT.

Sincerely

Richard A. Nebb
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San Francisco, CA 94111
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Claim 1

        1. (previously presented) A computer-readable medium encoded with computer programs having executable instructions for editing software applications that run on a data network which couples a server computer and a client computer, wherein the client computer runs a browser program, and whereupon request by the browser program, at least one of the applications generates generated documents for display by the browser program on a display device and responds to the request with the generated documents, comprising:
        a document generator program for running at least part of one of the applications being edited and generating the generated documents, ~~said generated documents including additional editing features for interpretation by the browser program; and~~
        <u>instructions for execution during the generating of the generated documents for including editing features for interpretation by the browser program into the</u>

<u>generated documents; and</u>
an editor program for dynamically operating on the generated documents displayed by the browser program via the editing features.

<u>Claim 22:</u>

Applicant still believes that claiming a document generator program executing components defines over java applets, since java applets are typically executed by a web browser and not by a document generator. Therefore, the following amendments should really not be required, but do clarify the claim language.

22. (previously presented) A computer-readable medium encoded with computer programs having executable instructions to edit and maintain applications using a web browser, comprising:
an editor program operating within the web browser on generated documents and having instructions for inserting, deleting, and modifying components on document templates; and
a document generator program having instructions <u>(i)</u> for processing document templates, ~~for executing said components,~~ <u>(ii)</u> for generating the generated documents from the document templates <u>for transmission to and display</u> ~~that are understandable~~ by the web browser, <u>and (iii) for executing said components to generate browser code for inclusion into the generated documents.</u>

These amendments make clear that the components generate browser code for inclusion into the generated documents, which are for transmission to the web browser, which applicant believes is not typically the case for java applets. Also, the language *"for transmission to the web browser"* defines over the page generator for the preview frame of WebWriter discussed in section 4.1.3 of the WebWriter II article; because that page generator works inside the browser, there is no transmission of the generated document to the browser taking place. In a previous interview, the examiner cited the 2nd para of section 4.1.4, which says *"requesting the server to send the appropriate HTML to the object property frame"*. In applicants reading, this citation does not apply to the preview frame, but to the document generator for the object property frame, and is therefore not a contradiction to applicants statement that the *page generator for the preview frame* works client side.

Distinctive Feature(s): WYSIWYG editing of dynamic parts

WebWriter I shows placeholders for dynamic areas during editing (see appeal brief section A.ii on p. 15 and figures on p.17). The placeholders in general look different from the end-user view. In contrast, applicant's editor shows dynamically generated parts of documents during editing.

The discussed portions of the WebWriter II article do not have any teaching of how to avoid the display of placeholders for dynamic areas. Fig.1 of the WebWriter II article seems to show editing of a static page, not a dynamic page, and does not give any information on how dynamic areas are handled during editing. Applicant thinks that any improvement in this respect would probably have been mentioned in the WebWriter II article.

Applicant wonders if the examiners acknowledge this as another distinctive feature.

Applicant believes that this feature is being recited in claim 26, by requiring modification of **dynamic** documents and by requiring that *at least a part of the second document appears and **functions** similar to the run-time view of the first document.* Applicant thinks that claiming similar appearance is an important limitation for requiring some kind of WYSIWYG editing and that WYSIWYG editing is an important and relevant feature.

Applicant believes that claim 59 also recites this distinctive feature.

Continuation App (12/966,976)

Some claims of the continuation resulted from rewriting previously allowed dependent claims of the parent case into independent form. Since the examiner(s) discussed an updated rejection based on WebWriter II for the parent, the same issues might arise for the continuation as well. Applicant therefore would like to propose some amendments to the claims in the continuation to avoid such a rejection in the continuation case.

Claim 1:

For claim 1 of the continuation, applicant proposes to make it explicit that the document generator program runs on the server computer. In a prior interview, the examiner affirmed that the page generator of WebWriter II, which is generating the documents shown in the preview frame, is recited as prior art. This page generator is

documented in section 4.1.3 of the WebWriter article and it is implemented in Javascript for execution inside the browser on the client. This is supported by the last para of section 4.1.3 *"This updates the display without any significant interaction with the server"* on page 1513.

In a prior interview, the examiner responded by citing the 2nd para of section 4.1.4, which states *"requesting the server to send the appropriate HTML to the object property frame"*. In applicants reading, this citation does not apply to the preview frame, but to the document generator for the object property frame and is therefore not a contradiction to applicants statement that the *page generator for the preview frame* works client side. Applicant therefore concludes that requiring the document generator to run on the server computer correctly defines over the document generator of the preview frame in WebWriter II and therefore the first amendment idea shown below should be sufficient.

Applicant also notes that this claim requires "executing instructions of said component on the server computer" which differentiates the claimed components from applets.

      1. A computer-readable medium encoded with computer programs having executable instructions for editing software applications that run on a data network which couples a server computer and a client computer, wherein the client computer runs a browser program, and wherein upon request by the browser program, the software applications generate generated documents for display by the browser program on a display device and respond to the request with the generated documents, comprising:

      a document generator program running <u>on the server computer and running</u> at least part of one of the software applications being edited and generating the generated documents, said generated documents including additional editing features for interpretation by the browser program; and

      an editor program dynamically operating on the generated documents displayed by the browser program via the editing features,

      the computer-readable medium further encoded with a plurality of components, wherein the software applications comprise at least one document template capable of containing components, and

      wherein the editor provides features to insert, modify, and delete a component on at least one document template,

      and wherein the document generator executes selected components on document templates, and wherein at least one of the components reacts interactively

on user input by executing instructions of said component on the server computer.

Rich Nebb

From:	Bullock, Lewis [Lewis.Bullock@USPTO.GOV]	**Sent:**	Wed 3/23/2011 2:30 PM
To:	Rich Nebb		
Cc:			
Subject:	RE: claims for discussion re 09/449021		
Attachments:			

I'll take a look at it and will let you know during our meeting.

Thanks

From: Rich Nebb [mailto:rnebb@dergnoah.com]
Sent: Wednesday, March 23, 2011 9:47 AM
To: Bullock, Lewis
Subject: claims for discussion re 09/449021
Importance: High

Dear Mr. Bullock:

We previously sent you a proposed amendment for discussion with regard to claim 1 only. We are now including proposals (see below) for discussion with regard to the other independent claims, and also, with regard to claim 1 of the child case (12/966,976), as well as selected comments.

We are scheduled to talk by telephone on Thursday March 24th at 2 pm EDT.

Sincerely

Richard A. Nebb
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Claim 1

     1. (previously presented) A computer-readable medium encoded with computer programs having executable instructions for editing software applications that run on a data network which couples a server computer and a client computer, wherein the client computer runs a browser program, and whereupon request by the browser program, at least one of the applications generates generated documents for

Rich Nebb

From:	Bullock, Lewis [Lewis.Bullock@USPTO.GOV]	**Sent:**	Thu 3/24/2011 8:03 AM
To:	Rich Nebb; Kendall, Chuck; Hayes, Gail		
Cc:			
Subject:	RE: claims for discussion re 09/449021		
Attachments:			

Mr. Nebb, I was hoping for an amendment like so below to further prosecution. We'll discuss during our interview.

1. (previously presented) A computer-readable medium encoded with computer programs having executable instructions for editing software applications that run on a data network which couples a server computer and a client computer, wherein the client computer runs a browser program, and whereupon request by the browser program, at least one of the applications generates generated documents for display by the browser program on a display device and responds to the request with the generated documents, comprising:

a document generator program for running at least <u>non-edited</u> part<u>s</u> of one of the applications being edited and generating the generated documents, ~~said~~ ~~generated documents including additional editing features for interpretation by the~~ ~~browser program; and~~

<u>and containing instructions for execution during the generating of the</u> <u>generated documents for including editing features for interpretation by the browser</u> <u>program into the generated documents and to perform edit operations initiated from</u> <u>the browser program on parts of one of the applications being edited for inclusion into</u> <u>the generated documents; and</u>

an editor program for dynamically operating on the generated documents displayed by the browser program via the editing features.

From: Rich Nebb [mailto:rnebb@dergnoah.com]
Sent: Wednesday, March 23, 2011 9:47 AM
To: Bullock, Lewis
Subject: claims for discussion re 09/449021
Importance: High

Dear Mr. Bullock:

We previously sent you a proposed amendment for discussion with regard to claim 1

Rich Nebb

From:	Rich Nebb	**Sent:**	Thu 3/24/2011 3:24 PM
To:	gail.hayes@uspto.gov; lewis.bullock@uspto.gov		
Cc:			
Subject:	follow up re 09/449021		
Attachments:			

Dear Ms. Hayes and Mr. Bullock,

Upon review, applicant came up with a claim for discussion that recites that the editing features are included in the generated document by the document generator, as was suggested by the examiners during the interview today. Applicant was concerned that an explicit recitation of instructions for that task contained in the document generator was not quite correct, because components actually assist in that task. However, applicant thinks and asks the examiners to verify that it is not incorrect to recite that the document generator performs the task of including the editing feature into the generated document. This is supported in the specification.

In the light of that, claim 2 (shown as 2A) could also be amended to make clear that components help with including the editing features into the generated document. By amending and limiting claim 2 in that way, another claim would be added (shown as 2B) to recite that components also help with generating the generated documents.

1. (xx) A computer-readable medium encoded with computer programs having executable instructions for editing software applications that ~~are~~ run<u>ning</u> on a data network which couples a server computer and a client computer, wherein the client computer runs a browser program, and whereupon request by the browser program, ~~at least one of the~~ <u>each</u> applications generates generated-documents ~~for display by the browser program on a display device~~ and responds to the request with the generated documents <u>for display by the browser program on a display device</u>, comprising:

a document generator program <u>for both (i)</u> running at least part of ~~one of~~ the applications being edited and generating the generated documents, ~~said generated documents~~ <u>and (ii)</u> including ~~additional~~ editing features for interpretation by the browser program <u>into the generated documents</u>; and

an editor program dynamically operating on the generated documents displayed by the browser program via the editing features.

2A. (xx) A computer-readable medium as in claim 1, further encoded with a plurality of components, and wherein the software applications comprise at least one document template capable of containing components, and wherein the editor <u>program</u> provides features to insert, modify and delete a component on at least one document template, and wherein the document generator <u>program makes use of</u> ~~executes~~ selected components on document templates <u>for including the editing features into the generated document</u>.

2B. (xx) A computer-readable medium as in claim 1, further encoded with a plurality of components, and wherein the software applications comprise at least one document template capable of containing components, and wherein the editor <u>program</u> provides features to insert, modify and delete a component on at least one document template, and wherein the document generator <u>program makes use of</u> ~~executes~~ selected components on document templates <u>for generating the generated documents</u>.

Re Term Extension

In light of the fact that the old rules apply to this case for term extension, as discussed with Ms. Hayes today, applicant wonders if it is possible to receive the discussed re-opening with a new rejection based on WebWriter in the form of a remand from the board.

Scheduled Telecon

Friday March 25th at 11 am EDT (8 am PDT).

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You forwarded this message on 3/25/2011 6:53 AM.

Rich Nebb

From:	Hayes, Gail [Gail.Hayes@USPTO.GOV]	**Sent:** Fri 3/25/2011 5:31 AM
To:	Rich Nebb; Bullock, Lewis; Kendall, Chuck	
Cc:	Hayes, Gail	
Subject:	DISCUSSED CHANGES	
Attachments:		

A system for editing software applications that run on a data network which couples a server computer and a client computer, wherein the client computer runs a browser program, and whereupon request by the browser program, at least one of the applications generates generated documents for display by the browser program on a display device and responds to the request with the generated documents, comprising an integrated processor, said processor including

a document generator portion running at least part of one of the applications being edited and generating the generated documents, and

an editor portion forming at least part of the editor used to include editing features for interpretation by the browser program into the generated documents;

Gail Hayes
WQAS 2190
571-272-3591

⊕ You forwarded this message on 3/25/2011 6:53 AM.

Rich Nebb

From:	Hayes, Gail [Gail.Hayes@USPTO.GOV]	**Sent:**	Fri 3/25/2011 5:31 AM
To:	Rich Nebb; Bullock, Lewis		
Cc:			
Subject:	RE: follow up re 09/449021		
Attachments:			

Mr. Nebb

Please note that your use of computer readable medium is probably going to raise issues under 101 unless you have somewhere in your spec defined the term to be such that carrier waves or signals is not included. Other than that I will let Mr. Bullock comment on the proposed changes

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From: Rich Nebb [mailto:rnebb@dergnoah.com]
Sent: Thursday, March 24, 2011 6:25 PM
To: Hayes, Gail; Bullock, Lewis
Subject: follow up re 09/449021

Dear Ms. Hayes and Mr. Bullock,

Upon review, applicant came up with a claim for discussion that recites that the editing features are included in the generated document by the document generator, as was suggested by the examiners during the interview today. Applicant was concerned that an explicit recitation of instructions for that task contained in the document generator was not quite correct, because components actually assist in that task. However, applicant thinks and asks the examiners to verify that it is not incorrect to recite that the document generator performs the task of including the editing feature into the generated document. This is supported in the specification.

In the light of that, claim 2 (shown as 2A) could also be amended to make clear that components help with including the editing features into the generated document. By amending and limiting claim 2 in that way, another claim would be added (shown as 2B) to recite that components also help with generating the generated documents.

1. (xx) A computer-readable medium encoded with computer programs having executable instructions for editing software applications that ~~are~~ running on a data network which couples a server computer and a client computer, wherein the client computer runs a browser program, and whereupon request by the browser program, ~~at least one of the~~ each applications generates generated-documents ~~for display by the browser program on a display device~~ and responds to the request with the generated documents for display by the browser program on a display device, comprising:

a document generator program for both (i) running at least part of ~~one of~~ the applications being edited and generating the generated documents, ~~said generated documents~~ and (ii) including ~~additional~~ editing features for interpretation by the browser program into the generated documents; and

an editor program dynamically operating on the generated documents displayed by the browser program

Rich Nebb

From:	Rich Nebb	**Sent:**	Wed 3/30/2011 6:26 AM
To:	gail.hayes@uspto.gov; lewis.bullock@uspto.gov; chuck.kendall@uspto.gov		
Cc:			
Subject:	follow up re 09/449021		
Attachments:			

Dear Ms. Hayes, Mr. Bullock and Mr. Kendall,

First, applicant appreciates the time and effort that each of you has invested recently to move this case forward. Thank you!

Second, applicant likes the claim you have proposed, and would like to use it as basis for obtaining allowable claims, either in the parent or in the child.

However, we present here one final attempt to persuade you that your interpretation of the prior art is incorrect. If we don't persuade you, then we will proceed with the appeal on at least this basis.

Applicant's understanding from the interview on March 25th is that the examiners believe that the WebWriter II article discloses executing scripts while generating the document shown in the preview frame, and that they think this view is supported by the following portions of WebWriter II:

"In editing mode the WebWriter II Editor displays the current page as interpreted HTML together with additional images called handles" (p1509, 2nd para)

and

"Definitions of JavaScript functions to walk the document tree and translate it to HTML that includes editing handles around each object" (p1513, 1st para, right column)

In other words, the examiners seem to believe (and applicant appreciates any correction in case he misunderstood the examiners on the phone) that WebWriter II teaches running scripts contained in the document tree during the process to generate the appropriate HTML for the preview frame. Applicant disagrees, and submits that this interpretation is overbroad and not supported by the article, since there is nothing in the article that explicitly says that. For example, the WebWriter I article also discloses generating HTML for the document tree (see last para. of right column, p. 8: *"traversing the content tree"*), but does not seem to execute the scripts. Instead,

placeholders are inserted for the dynamic areas associated with server side scripts (last para. of right column, p. 4: *"WebWriter then adds a placeholder for the output area"*). This is discussed in detail in applicant's appeal brief at sec. A.ii on p. 15, including the figures on p.17.

In applicants reading, the portions cited above (and the article as a whole) cannot be taken as a teaching or suggestion that WebWriter II does anything differently than WebWriter I with regard to the scripts and the placeholders, although the document generator is newly written in javascript and moved from the server to the client. The fact that HTML is generated does not teach or suggest that scripts are executed, since placeholders are represented as HTML as well.

On the other hand the scripts associated with dynamic areas of WebWriter, which are cited against applicants components, are server side scripts and actually unix programs (WebWriter I at p. 9, column 2: *"runs the named program on its arguments"* ... *"The program is run in a separate Unix process"*), and therefore cannot normally run (especially at the time the article was written) inside a browser or be called by a JavaScript function. Execution of the scripts on the server would require server interaction, but the last paragraph of section 4.1.3 of WebWriter II (p. 1513), describing the preview frame, says: *"This updates the display **without** requiring any significant interaction with the server."*

Applicant notes that claims are written or could be amended to refer to server side (or at least non-browser scripts / components), and that this should also define over java applets (Faustini patent), since java applets also seem to be executed by the browser on the client and not by a page generator on the server.

We invite you to reconsider your position.

Richard A. Nebb
DERGOSITS & NOAH LLP
3 Embarcadero Center, Suite 410
San Francisco, CA 94111
(707) 340.3453 telephone
(415) 705.6377 telephone
(415) 705.6383 fax

NPL76

🜲 This message was sent with high importance.

Rich Nebb

From:	Rich Nebb	**Sent:**	Fri 4/8/2
To:	gail.hayes@uspto.gov; lewis.bullock@uspto.gov; chuck.kendall@uspto.go		
Cc:			
Subject:	claims follow up re 12/966976 (cont. of 09/449021)		
Attachments:			

Re: App. No. 12/966,976 (cont. of 09/449,021)

Dear Ms. Hayes, Mr. Bullock and Mr. Kendall:

Applicant is working to finalize amendments in the continuation case, and with 13 independent claims of varying scope and language, it may be advantageous to talk further regarding these claims, prior to offering an amendment, in light of the following:

- Applicant will amend several independent claims including (1, 8, 11, 12, 21, 24 and 41) to incorporate the agreed upon language or a variation thereof. It would be nice to confirm that the language used by applicant is acceptable. See claims 1, 8 and 21 appended below.

- Applicant thinks that claims 13 and 48 recite a similar but different distinctive feature not yet discussed. These claims explicitly include components, and just like the integrated processor, the components have, in addition to a portion that generates browser code, a portion that assists and cooperates in editing the components (see Appeal Brief at p.29, sec. B.vi). This feature is recited in these claims as follows:
  claim 13: *"each component having features to cooperate in editing the component"* claim 48: *"at least one of the components including first features adapted to cooperate with an editor in editing"*.

  Applicant seeks confirmation from the examiners that this is a distinctive feature and that it is recited correctly in the claims. See claims 13 and 48 appended below.

  With regard to the properties of components in the prior art, these are described in detail on p. 9 of the WebWriter I article, and thus a new rejection on the basis of WebWriter II does not seem appropriate.

- Claim 25 recites another distinctive feature: *"the set of components on the generated documents can vary for different document requests for said document template,"* which in applicant's reading is also not shown by WebWriter as discussed in the Appeal Brief at p.33, section B.ix. See claim 25 appended below.

Please advise.

Sincerely,

Richard A. Nebb
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3 Embarcadero Center, Suite 410
San Francisco, CA 94111
(707) 340.3453 telephone
(415) 705.6377 telephone
(415) 705.6383 fax

1. A <u>non-transitory</u> computer-readable medium encoded with computer programs having executable instructions for editing software applications that run on a data network which couples a server computer and a client computer, wherein the client computer runs a browser program, and wherein upon request by the browser program, the software applications generate generated documents for display by the browser program on a display device and respond to the request with the generated documents, comprising:

<u>an integrated processor having computer executable instructions, said integrated processor including</u>

a document generator ~~program~~ <u>portion</u> running at least part of one of the software applications being edited and generating the generated documents <u>for transmission to the browser program in response to a request by the browser program,</u> ~~said generated documents including additional~~ <u>and</u>

<u>an editor portion forming at least part of an editor, the editor used to include</u> editing features for interpretation by the browser program into the generated documents, <u>to permit editing on the generated documents displayed by the browser program</u>

~~and~~

~~an editor program dynamically operating on the generated documents displayed by the browser program via the editing features;~~

~~the computer-readable medium further encoded with a plurality of components, wherein the software applications comprise at least one document template capable of containing components, and~~

~~wherein the editor provides features to insert, modify, and delete a component on at least one document template;~~

~~and wherein the document generator executes selected components on document templates, and wherein at least one of the components reacts interactively on user input by executing instructions of said component on the server computer.~~

8. A system ~~having~~ for use with a data network which couples a server computer to a client computer, the server computer running an application to modify dynamic documents on the server computer, said dynamic documents operating by being transformed into a final page upon a request by a web browser the server computer comprising:

a document store;

a first integrated software program running on the server computer including:

a document generator portion including instructions for transforming at least one first dynamic document retrieved from the document store into a second document, and

an editor portion forming at least part of an editor, the editor used to include ~~having~~ features into the second document which permit editing of the first document, such that at least a part of the second document appears and functions similar to the final page ~~run-time view~~ of the first dynamic document wherein the first dynamic document includes at least one component being executed by the first software program, the component generating code for the final page ~~run-time view~~ of the first document; and

a second software program including instructions to receive information from the client computer and instructions to modify the first dynamic document stored in the document store.

13. A system having at least one computer running a second software program for editing components on web document templates for use with a first software program including first instructions for generating a document request to obtain at least one generated document from the second software program and for displaying the generated document, the second software program capable of receiving and processing the document request and of transmitting first documents to the first software program in response to requests, said system comprising:

a plurality of components in a data store, each component containing executable instructions to generate browser code and each component having features to cooperate in editing the component,

a plurality of document templates,

the second software program transmitting, while processing selected requests, second documents to the first software program that make the first software program display a user interface on a display device, said user interface providing for editing functions used for maintaining components on document templates, and

a third software program used by the second software program while processing selected document requests, the third software program including third instructions for modifying document templates in order to perform said editing functions.

21. A software development system having at least one computer running an application for developing dynamic web documents, said dynamic web documents operating by being transformed into an end user's view upon a request by a web browser, the end user's view being provided to the browser for display on a display device in response to the request, comprising:

an editor program having instructions for dynamically editing dynamic web documents,

an integrated processor running on the computer including a document generator portion and an editor portion, the a document generator portion program having instructions for generating generated documents from dynamic web documents which look and function similar to the end user's view of the documents with the addition of editing features, the editor portion forming at least part of an editing extension, the editing extension used to generate editing features for cooperation with the editor program,

the editor program comprising first instructions for requesting that the document generator program processes a dynamic web document during editing thereby resulting in a generated document,

the system comprising second instructions for displaying <u>on the display device</u> at least some information items contained on said generated document in a view which allows the user to select an item to which a modification function will be applied,

the editor program comprising third instructions to modify the dynamic web document to perform said modification function;

~~a plurality of components including at least one component marked on said dynamic web document and including instructions for use by the document generator program to generate browser code~~.

25. A system having at least one computer running an application for developing document templates that are intended for transformation into generated documents for display by a first software program, the first software program including first instructions for generating a document request to obtain at least one generated document and for displaying the generated document on a display device, comprising:

<u>the computer having a data store containing</u> a plurality of components <u>each</u> having instructions to generate browser code for transmission to the first software program,

an editor program having instructions for performing editing functions to maintain components on document templates, the components having the ability to cooperate with the editor,

a plurality of document templates having said components denoted thereon, and

a document generator program <u>for execution on the computer</u> having instructions to, upon document requests, generate generated documents from at least one document template for display by the first software program <u>on the display device</u> wherein the set of components on the generated documents can vary for different document requests for said document template.

48. A system for displaying dynamically generated documents, the system having a data network coupling a server computer to a client computer, wherein the client computer has a first software program including first program instructions for generating a request to obtain at least one generated document from the server computer and for displaying the generated document on a display device, comprising:

a plurality of components having instructions for execution on the server computer, at least one of the components including first features adapted to cooperate with an editor in editing said component and second program instructions to generate browser code, and

a program having instructions on the server for dynamically generating generated documents for transfer to the client computer based on the data contained in a request initiated by the client computer, thereby using second program instructions of selected components.

Rich Nebb

From:	Hayes, Gail [Gail.Hayes@USPTO.GOV]	**Sent:**	Sun 4/10/2011 10:32 AM
To:	Rich Nebb; Bullock, Lewis; Kendall, Chuck		
Cc:			
Subject:	RE: claims follow up re 12/966976 (cont. of 09/449021)		
Attachments:			

All

I have concerns that while the agreed upon language may overcome prior art (but I leave that to Mr. Bullock and Mr. Kendall), it does not address another issue we discussed. I will telephone Mr. Nebb with that issue

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From: Rich Nebb [mailto:rnebb@dergnoah.com]
Sent: Friday, April 08, 2011 1:23 PM
To: Hayes, Gail; Bullock, Lewis; Kendall, Chuck
Subject: claims follow up re 12/966976 (cont. of 09/449021)
Importance: High

Re: App. No. 12/966,976 (cont. of 09/449,021)

Dear Ms. Hayes, Mr. Bullock and Mr. Kendall:

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- Applicant thinks that claims 13 and 48 recite a similar but different distinctive feature not yet discussed. These claims explicitly include components, and just like the integrated processor, the components have, in addition to a portion that generates browser code, a portion that assists and cooperates in editing the components (see Appeal Brief at p.29, sec. B.vi). This feature is recited in these claims as follows:
  claim 13: *"each component having features to cooperate in editing the component"* claim 48: *"at least one of the components including first*